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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,300	03/27/2001	Masanori Kawashima	35.C15221	7780

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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT PAPER NUMBER

2157

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/817,300	<b>Applicant(s)</b> KAWASHIMA, MASANORI	
	<b>Examiner</b> Hussein A. El-chanti	<b>Art Unit</b> 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12,15-22,25-27,30-32,35,36,39,40,43,44 and 53-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-12,15-22,25-27,30-32,35,36,39,40,43,44 and 53-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to amendment received on July 3, 2006. Claims 3-4, 13-14, 23-24, 28-29, 33-34, 37-38, 41-42 and 45-52 were canceled. Claims 53-60 were newly added. Claims 1-2, 5-12, 15-22, 25-27, 30-32, 35-36, 39-40, 43-44 and 53-60 are pending examination.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/817,300 received on June 21, 2001.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 53-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 53-60 state "second designated step was not designated in the first designating step".

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be

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explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5-7, 9-12, 15-17, 19-22, 25-27, 30-32, 35-36, 39-40, 43-44 and 53-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Leiman et al., U.S. Patent No. 7,072,067 (referred to hereafter as Leiman).

As to claims 1, 11, 21, 26, 31, 35, 39 and 43, Leiman teaches a network-managing method, device, program and medium for providing a device list with which

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device information with regard to a plurality of devices is arranged in order and displayed for every device, comprising:

a first designating step of accepting a user designation of an item of at least one device information specified to be displayed in the device list (see col. 7 lines 30-43, a dialogue box is displayed to a user to select an option);

a second designating step of an item of an item of at least one device information wherein the plurality of records comprised in the device list are sorted based on the item of the device information designated by the user in the second designating step (see col. 7 lines 37-67 and col. 8 lines 30-col. 9 lines 6, the devices are listed according to the user selection);

a setting step of setting the item of the device information designated by the user in the second designating step to an item of a device information to be displayed in the device list, in a case where the item of the device information is designated by the user in the second designating step (see col. 7 lines 37-67); and

a display control step to display the device list that comprises the plurality of records which are sorted based on the item of the device information designated by the user in the second designating step (see col. 7 lines 37-67 and fig. 8-15);

wherein each of the plurality of records comprises device information corresponding to the item of the device information designated by the user in the first designating step and device information corresponding to the item of the device information designated by the user in the second designating step (see col. 7 lines 37-67 and fig. 8-15).

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As to claims 2, 12, 22, 27, 32, 36, 40 and 44, Leiman teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a display step of displaying the device list on a display area (see col. 7 lines 37-67 and fig. 8-15).

As to claims 5, 15, 25 and 30, Leiman teaches the method, device, program and medium according to claims 1, 15, 25 and 30 respectively, comprising:

a detection step of detecting a plurality of devices connected to a network; a device information obtaining step of obtaining a device information from a detected a plurality of devices; and a device list generation step of generating a device list data representing the device list based on a obtained device information (see col. 8 lines 30-col. 9 lines 6).

As to claims 6 and 16, Leiman teaches the method according to claims 5 and 15, comprising a storing step of storing obtained device information in a memory area, and, in the device list generation step, generating the device list data based on a device information stored in the memory area (see col. 8 lines 30-col. 9 lines 6).

As to claims 7 and 17, Leiman teaches the method according to claims 5 and 15, comprising; a transmitting step of transmitting a generated device list data to a network; and a display controlling step of analyzing the transmitted device list data and having a display area display the device list (see col. 8 lines 30-col. 9 lines 6).

As to claims 9 and 19, Leiman teaches the method according to claims 8 and 18, wherein the device is a printer (see col. 8 lines 30-col. 9 lines 6).

As to claims 10 and 20, Leiman teaches the method according to claims 1 and 11, wherein the device information is at least one selected from the group of device name, device product name, location of device installation, device network address and device MAC address (see col. 8 lines 30-col. 9 lines 6).

As to claims 53-60, Leiman teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a judging step wherein in a case where it is judged that the item designated in said second designated step was not designated in the first designating step, said setting step sets the item designated in said second designating step to the item to be displayed in the device list (see col. 7 lines 45-col. 9 lines 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Leiman in view of Carcerano et al., U.S. Patent No. 6,308,205 (referred to hereafter as Carcerano).

As to claims 8 and 18, Leiman teaches a system and method for displaying and modifying a list of devices according to user selected parameters where the list is displayed to the using a browser where the list is transmitted to the network using TCP/IP protocol (see abstract and fig. 9-15).

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Leiman does not explicitly teach that the list data is data described in HTML and the list is being transmitted to a network using HTTP protocol. However, Carerano teaches a system and method for obtaining a list of devices on a network using HTML files and sending the list to a network user using HTTP protocol.

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Leiman by creating the device list file using "HTML" since HTML format is very well known in the art to be a simple language and therefore using HTML would allow the system data to be compatible with a wide range of software programs. Also HTTP is well known protocol in the art to be the main protocol used to transfer HTML data on a network and therefore it would have been obvious for one of the ordinary skill in the art to use HTTP in Leiman to transfer HTML data list on a network because doing so would make Leiman compatible with almost all web browsers.

### ***Response to Arguments***

6. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

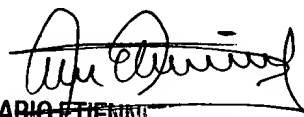
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Sep. 26, 2006

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER